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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,685	11/07/2000	Julio C. Palmaz	6006-015	9696

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EXAMINER
MILLER, CHERYL L

ART UNIT	PAPER NUMBER
3738	

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/707,685	PALMAZ ET AL.	
	Examiner	Art Unit	
	Cheryl L. Miller	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 October 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-23 and 29-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-23 and 29-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed on April 14, 2002 does not fully comply with the requirements of 37 CFR 1.98 because: only pages 1-11 of the 25 pages were received. Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above mentioned omissions or corrections in the information disclosure statement. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b). Failure to timely comply with this notice will result in the above mentioned information disclosure statement being placed in the application file with the noncomplying information **not** being considered. See 37 CFR 1.97(i).

Response to Arguments

2. Applicant's arguments with respect to claims 14-23 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

1. Claims 14-23 and 29-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 9-26 of copending Application No. 09/745,304. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined application only differs by adding the limitation of longitudinal and circumferential members to the independent claim. It is common knowledge in the art that most stents consist of longitudinal and circumferential members in order to provide flexibility and expansion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to the limitation of longitudinal and connecting circumferential members to a stent in order to provide flexibility and expansion.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The examiner has recognized there is at least one common inventor with the two applications. However, in the case of a double patenting rejection, the inventive entity must be the same in both applications. It appears there might be an error in the inventorship of at least one of the applications.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 14-21, 23, 29-30, 33-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Clubb et al. (USPN 6,203,732 B1). Referring to claims 14 and 29, Clubb discloses a method of manufacturing a stent (col.1, lines 6-10) comprising providing a substrate (10) having a continuously curved exterior surface, vacuum depositing a metal onto the substrate, forming a plurality of interconnected structural elements, and removing the substrate (col.2, lines 25-36).

Referring to claims 15 and 16, Clubb discloses imparting a pattern (100c) onto the substrate (10) and selective deposition of the metal onto the pattern (col.3, lines 48-55).

Referring to claim 17, Clubb discloses depositing a sacrificial layer (16) of material onto the substrate (10).

Referring to claims 18-20, 23, 30, and 33, Clubb discloses vacuum depositing metal by ion beam evaporation or sputtering (col.5, lines 35-47).

Referring to claims 21 and 34, Clubb discloses a cylindrical substrate (cylindrical surface, 12).

Referring to claims 35-38, Clubb discloses control of heterogeneities and by controlling the type of material used during deposition, properties such as grain size, phase, material composition, binding sites, strength, etc. are inherently controlled (col.5, lines 10-25).

5. Claims 14, 17-20, and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Roth (USPN 6,096,175, cited in previous office action). Referring to claim 14, Roth discloses a method of manufacturing a stent (col.1, lines 4-6) comprising providing a substrate (36) having an exterior surface, vacuum depositing a stent forming metal (42, 56) onto the substrate (36), and removing the substrate.

Referring to claim 17, Roth discloses depositing a sacrificial layer (50) onto the substrate.

Referring to claims 18-20 and 23, Roth discloses vacuum deposition by ion beam evaporation or sputtering, wherein the evaporation is in the presence of an inert gas selected from the group of argon, xenon, nitrogen and neon (col.5, lines 25-40; col.6, lines 19-23).

Referring to claim 22, Roth discloses a planar substrate (36).

6. Claims 14, 17-19, 21-22, 29-30, and 34-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Reed et al. (USPN 6,197,013 B1, cited in previous office action). Referring to claims 14 and 29, Reed discloses a method of manufacturing a stent (col.11, lines 40-41) comprising providing a substrate having a continuously curved exterior surface (col.10, lines 62-63), vacuum depositing a metal onto the substrate (col.10, lines 65-67), defining a plurality of interconnected structural elements (col.11, lines 2-3), and removing the substrate (col.11, lines 4-5).

Referring to claim 17, Reed discloses depositing a sacrificial layer (SiO_2) of material onto the substrate.

Referring to claims 18-19 and 30, Reed discloses vacuum depositing metal by ion beam evaporation or sputtering (col.9, lines 51-54; col.10, lines 65-67).

Referring to claims 21-22 and 34, Reed discloses a cylindrical substrate (col.10, lines 62-63) or a planar substrate (col.10, lines 12-15).

Referring to claims 35-38, Reed discloses control of heterogeneities and by controlling the type of material used during deposition, properties such as grain size, phase, material composition, binding sites, strength, etc. are inherently controlled (col.11, lines 39-52).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clubb et al. (USPN 6,203,732 B1) in view of Roth (USPN 6,096,175). Clubb discloses a method of manufacturing a stent by vacuum deposition (see above), however does not disclose vacuum deposition of nickel-titanium. Roth teaches in the same field of endeavor, a method of manufacturing a stent by vacuum deposition of nickel titanium in order to form a stent with shape memory properties, allowing expansion at specific temperatures (col.4, lines 34-42; col.6, lines 8-16). It would have been obvious at the time the invention was made to combine Roth's material choice for vacuum deposition, with the method of manufacturing stents by Clubb, in order to manufacture a nickel titanium stent with shape memory properties, allowing expansion at a specific temperature.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl L. Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Cheryl Miller
December 27, 2002

BRUCE SNOW
PRIMARY EXAMINER